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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,359	12/06/2000	John H. Jebens	29544/36981	8464

4743 7590 08/05/2002

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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 08/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,359

Applicant(s)

JEBENS ET AL.

Examiner

Ella Colbert

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 91-126 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 91-126 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3624

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figs. 3A –3B, block 130 is missing, fig. 6, blocks 301, 303, 305, & 307 are missing, fig. 7A, block 411 is missing, fig. 7B, blocks 413, 415, 417, 419, & 421 are missing, fig. 7C, block 427 is missing, fig. 8A, blocks 501, 503, 505, 507, & 509 are missing, fig. 8B, blocks 511, 515, 517, 519, & 521 are missing, fig. 8C, blocks 523, 525, 527, 529, & 531 are missing, fig. 9A, blocks 615, 633, 635, 637, & 639 are missing, and fig. 9B, blocks 641, 643, 645, & 647-678 are missing from the drawing figures. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Fig. 2, block 50, fig. 3B, blocks 124 & 128, fig. C, blocks 768 & 786, fig. 10D, block 761, fig. 10F, blocks 756, 766, 767, 820, & 831, and fig. G, blocks 760, 762, & 764 are missing from the description in the Specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 91, 92, 94, & 113 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 91, 92, 94, & 113 recite "a host". It is not clear to the Examiner whether Applicants' mean a "host server" or a "host computer". For examination purposes, the Examiner assumes the Applicants' mean a "host server". Clarification and correction is requested in the claim language.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 91, 92, & 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 5,153,936) Morris et al, hereafter Morris.

With respect to claims 91 and 113, Morris teaches, receiving a high resolution digital image at the host from a first user via the Internet (col. 2, lines 5-14); storing the low resolution copy of the high resolution digital image at the host, the stored low resolution copy of the high resolution digital image having a pathname (col. 2, lines 43-48 and lines 64-67, and col. 3, lines 1-7); downloading the low resolution copy of the high resolution digital image to the first user via the Internet if the first login information

Art Unit: 3624

is valid (col. 6, lines 2-19); detecting a selection made by the first user, the selection made by the first user identifying the low resolution copy of the high resolution digital image (col. 7, lines 51-68 and col. 8, lines 1-2); downloading the low resolution copy of the high resolution digital image to the second user via the Internet (col. 10, lines 46-56); and routing the high resolution digital image to a printer associated with the host (col. 2, lines 49-55).

The Office take Official Notice that the steps of receiving login information at the host from the first user, the login information including a first user identifier (login ID) and first password; determining if the first login information is valid; and receiving data from the first user identifying a second user are all old and well known in the art of logging onto the Internet and a computer system.

Morris did not teach, e-mailing a notification message from the host to the second user via the Internet and transmitting at least a portion of the pathname to the second user via the Internet, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to e-mail a notification message from the host to the second user via the Internet and to transmit at least a portion of the pathname to the second user via the Internet and to modify in Morris because such a modification would allow Morris to receive an e-mail informing him when he could expect a digital image and to have a filing system that leads from the current directory to a file to the second user via the Internet.

With respect to claim 113, Morris teaches, responding to the identification data from the first user by routing the low resolution copy of the high resolution digital image to the second user via the Internet (col. 3, lines 8-17 and lines 44-51).

Art Unit: 3624

With respect to claim 92, Morris teaches, the step of routing the high resolution digital image to a printer associated with the host is performed in response to an input (col. 2, lines 5-14) from the second user (col. 2, lines 49-55).

7. Claims 93-96, 114, & 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris in view of (US 5,426,594) Wright et al, hereafter Wright.

With respect to claim 93, Morris did not teach, at least a portion of the notification message is prepared by the first user. Wright discloses, at least a portion of the notification message is prepared by the first user (col. 5, lines 14-22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have at least a portion of the notification message is prepared by the first user and to combine Morris' routing the high resolution digital image with Wright's at least a portion of the notification message is prepared by the first user and to modify in Morris because such a modification would allow Morris to have an electronic mail system for sending e-mail notification messages.

With respect to claim 94, Morris did not teach, at least a portion of the notification message sent from the host to the second user via the Internet comprises a message from the first user to the second user. Wright discloses, at least a portion of the notification message sent from the host to the second user (subscriber) via the Internet comprises a message from the first user (consumer) to the second user (col. 5, lines 41-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have at least a portion of the notification message sent from the host to the second user via the Internet comprising a message from the first user to the second user and to combine Morris' downloading and routing the digital image with Wright's at least a portion of the notification message sent from the host to the second

Art Unit: 3624

user via the Internet comprising a message from the first user to the second user and to modify in Morris because such a modification would allow Morris to have an electronic mail system for sending e-mail notification messages and to receive incoming messages.

With respect to claims 95 & 114, Morris did not teach, the step of receiving data from the first user identifying a second user comprises the step of receiving authorization data from the first user, the authorization data specifying that the second user is to be granted access to digital images of the first user. Wright discloses, the step of receiving data from the first user identifying a second user comprises the step of receiving authorization data from the first user, the authorization data specifying that the second user is to be granted access to digital images of the first user (col. 5, lines 64-68 and col. 6, lines 1-6 and lines 15-22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have at least a portion of the notification message sent from the host to the second user via the Internet comprising a message from the first user to the second user and to combine Morris' routing the high resolution digital image with Wright's at least a portion of the notification message sent from the host to the second user via the Internet comprising a message from the first user to the second user and to modify in Morris because such a modification would allow Morris to have an electronic mail system for sending e-mail notification messages and to receive incoming messages.

With respect to claims 96 & 115, Morris nor Wright teach, the step of associating a second user identifier and a second password with the second user, the second user identifier being different than the first user identifier, the second password being different than the first password, but it would be obvious to one having ordinary skill in

the art at the time the invention was made to have a step associating a second user identifier and a second password with the second user, the second user identifier being different than the first user identifier, the second password being different than the first password and to modify in Morris and Wright because such a modification would allow Morris and Wright to have a secure system for transmitting digital images since the password and user id are always different for each user on the Internet.

8. Claims 97-102 & 116-120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris and Wright further in view of (US 6,154,755) Dellert et al, hereafter Dellert.

With respect to claims 97 & 116, Morris nor Wright teach, the step of generating a low resolution copy of the high resolution digital image comprises the step of generating a thumbnail JPEG file by making a copy of the high resolution digital image and discarding some of the pixel information. Dellert discloses, the step of generating a low resolution copy of the high resolution digital image comprises the step of generating a thumbnail JPEG file by making a copy of the high resolution digital image and discarding some of the pixel information (col. 5, lines 8-38). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a step of generating a low resolution copy of the high resolution digital image comprises the step of generating a thumbnail JPEG file by making a copy of the high resolution digital image and discarding some of the pixel information and to combine Morris' downloading a low resolution copy of the high resolution digital image and Wright's distribution of digital images with Dellert's step of generating a low resolution copy of the high resolution digital image comprises the step of generating a thumbnail JPEG file by making a copy of the high resolution digital image and discarding some of the pixel

information and to modify in Morris and Wright because such a modification would allow Morris and Wright's systems to have a thumbnail and higher resolution digital images that are saved as uncompressed images and then converted to JPEG files.

With respect to claims 98 & 117, Morris nor Wright teach, the step of translating the low resolution copy of the high resolution digital image from a first file format to a second file format, the first file format being different than the second file format. Dellert discloses, the step of translating the low resolution copy of the high resolution digital image from a first file format to a second file format, the first file format being different than the second file format (col. 5, lines 11-17 and lines 36). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a step of translating the low resolution copy of the high resolution digital image from a first file format to a second file format, the first file format being different than the second file format and to combine Morris' downloading a low resolution copy of the high resolution digital image and Wright's distribution of digital images with Dellert's step of translating the low resolution copy of the high resolution digital image from a first file format to a second file format, the first file format being different than the second file format and to modify in Morris and Wright because such a modification would allow Morris and Wright's systems to have a list of categories and a list of thumbnails and higher resolution images that are converted to JPEG files.

With respect to claims 99 & 118, Morris, Wright nor Dellert teach, the step of storing the low resolution copy of the high resolution digital image comprises the step of storing the low resolution copy of the high resolution digital image in a file format selected by the first user, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a step for storing the low resolution copy of the high resolution digital image comprising the step of storing the low resolution

Art Unit: 3624

copy of the high resolution digital image in a file format selected by the first user and modify in Morris, Wright, and Dellert because such a modification would allow Morris', Wright's, and Dellert's systems to have a file format that is compatible to a selected printer.

With respect to claim 100, Morris, Wright, nor Dellert teach, the step of downloading the low resolution copy of the high resolution digital image to the second user via the Internet comprises the step of downloading the low resolution copy of the high resolution digital image in a file format selected by the second user, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a step of downloading the low resolution copy of the high resolution digital image to the second user via the Internet comprises the step of downloading the low resolution copy of the high resolution digital image in a file format selected by the second user and to modify in Morris, Wright, and Dellert because such a modification would allow Morris', Wright's, and Dellert's systems to have the ability for a user to select a file format that is compatible for printing the digital image.

With respect to claim 101, Morris nor Wright teach, comprising the step of causing dummy thumbnails in the form of standardized icons to be displayed. Dellert discloses the step of causing dummy thumbnails in the form of standardized icons to be displayed (col. 2, lines 20-42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a step of causing dummy thumbnails in the form of standardized icons to be displayed and to combine Morris' high resolution digital image and Wright's receiving data with Dellert's step of causing dummy thumbnails in the form of standardized icons to be displayed and to modify in Morris and Wright because such a modification would allow Morris and Wright to have a

Art Unit: 3624

miniature version of an image or electronic version of a page that is generally used to allow quick browsing through multiple images or pages.

With respect to claims 102 & 119, Morris nor Wright teaches, the step of downloading the low resolution copy of the high resolution digital image to the second user via the Internet is performed in response to the second user clicking on an icon. Dellert discloses, the step of downloading the low resolution copy of the high resolution digital image to the second user via the Internet is performed in response to the second user clicking on an icon (col.1, lines 20-27 and col. 3, lines 3-11 and lines 44-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a step of downloading the low resolution copy of the high resolution digital image to the second user via the Internet performed in response to the second user clicking on an icon and to modify in Morris and Wright because such a modification would allow Morris and Wright's to have a systems to have a program for showing the images one at a time on a display associated with a personal computer to produce a virtual slide show.

With respect to claims 103 & 120, Morris, Wright, and Dellert did not teach, comprising the step of maintaining transparency of the high resolution digital image with respect to a plurality of non-authorized users, but it would have been obvious to one having ordinary skill in the art at the time the invention was made to have a step for maintaining transparency of the high resolution digital image with respect to a plurality of non-authorized users and to modify in Morris, Wright, and Dellert because such a modification would allow Morris, Wright, and Dellert to have the translation of the low resolution digital image and the high resolution digital image to be transparent to a user of the system.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claim 104-112 & 121-125 are rejected under the judicially created doctrine of double patenting over claims 4-6, 9, 12-14, 17, 20, & 23 of U. S. Patent No. 6,332,146 although the conflicting claims are not identical, they are not patentably distinct from each other because they relate to a method and system for managing and the distributing (delivery) of digital images and use most of the same claim limitations as found in the '146 patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the '146 patent and the 09/731,359 ('359) claims an electronic storage facility for providing storage for high resolution digital images of a plurality of unrelated image providers ..., a image handling means for processing the high resolution images, a mail database, a search engine for searching among digital

Art Unit: 3624

images, a storage device for providing storage for the digital images, a router for electronically routing at least one high resolution copy of a digital image, the digital images input to the system by the first image provider, an image handler for processing the digital images, steps for receiving a plurality of digital images, storing a high resolution and a low resolution copy of each of the second plurality of digital images, permitting a first authorized user identified by the first image provider, receiving a request from the first authorized user, receiving instructions from the first authorized user, and automatically electronically routing the high resolution copy, a search engine for developing a subset of the digital images stored in the storage device, a job order developer, a router for electronically routing the job order, and a user identifier for discriminating between users.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

11. Claims 104-112 & 121-126 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims claims 4-6, 9, 12-14, 17, 20, & 23 of U. S. Patent No. 6,332,146 ('146). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claims 104 and 121 of the instant application, contains the phrase "an electronic storage facility for providing storage for high resolution digital images of a plurality of

unrelated image providers, at least some of the high resolution digital images stored in the electronic storage facility being used to develop corresponding low resolution copies, each high resolution digital image having a higher bandwidth communication requirement than each of the corresponding low resolution copies, the electronic storage facility storing the high resolution digital images of a first one of the image providers such that the high resolution digital images of the first image provider and such that the high resolution digital images of the first image provider are transparent to other unrelated image providers that are not authorized by the first image provider means for notifying an authorized user identifier by the first image provider that the authorization has been authorized to download a low resolution copy of the high resolution digital image, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy of the authorized user." Claim 4 of the '146 patent contains all of the claim limitations of claims 104 and 121 except the phrases "means for notifying an authorized user identified by the first image provider that the authorization has been authorized to download a low resolution copy of the high resolution digital image, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy to the authorized user; means for allowing the authorized user to download the low resolution copy of the high resolution digital image of the first image provider from the electronic storage facility to a first location; means for electronically routing the high resolution digital image to a printer in response to a request from the authorized user; means for downloading a low resolution copy of a high resolution digital image to the first image provider; means for electronically routing the low resolution copy of the high resolution digital image to an authorized user identified by the first image provider in response to a routing request from the first image provider; means for allowing the authorized user to identify a high

Art Unit: 3624

resolution digital image; and means for electronically routing the high resolution digital image from the host to a printer.” However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the ‘146 patent to arrive at claims 104 and 121 of the instant application, by simply including means for notifying an authorized user identified by the first image provider that the authorization has been authorized to download a low resolution copy of the high resolution digital image, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy to the authorized user; means for allowing the authorized user to download the low resolution copy of the high resolution digital image of the first image provider from the electronic storage facility to a first location; means for electronically routing the high resolution digital image to a printer in response to a request from the authorized user; means for downloading a low resolution copy of a high resolution digital image to the first image provider; means for electronically routing the low resolution copy of the high resolution digital image to an authorized user identified by the first image provider in response to a routing request from the first image provider; means for allowing the authorized user to identify a high resolution digital image; and means for electronically routing the high resolution digital image from the host to a printer. The scope of claim 4 of the ‘146 patent encompasses all of the elements of the instant claims 104 and 121 except the steps of “means for notifying an authorized user identified by the first image provider that the authorization has been authorized to download a low resolution copy of the high resolution digital image, wherein the notifying means transmits at least a portion of a pathname associated with the low resolution copy to the authorized user; means for allowing the authorized user to download the low resolution copy of the high resolution digital image of the first image provider from the electronic storage facility to a first location; means for electronically

Art Unit: 3624

routing the high resolution digital image to a printer in response to a request from the authorized user; means for downloading a low resolution copy of a high resolution digital image to the first image provider; means for electronically routing the low resolution copy of the high resolution digital image to an authorized user identified by the first image provider in response to a routing request from the first image provider; means for allowing the authorized user to identify a high resolution digital image; and means for electronically routing the high resolution digital image from the host to a printer.”

With respect to claim 105 of the instant application, contains the phrase “further comprising image handling means for processing the high resolution digital images to develop the corresponding low resolution copies which is the same limitation as for the ‘146 patent.

With respect to claim 106 of the instant application, contains the phrase “further comprising a mail database, the mail database including a conventional address for the authorized user which is the same limitation as for the ‘146 patent.

With respect to claim 107 of the instant application, contains the phrase “further comprising a search engine for searching among digital images stored in the storage device” which is part of the claim limitation for claim 9 in the ‘146 patent.

With respect to claim 108 of the instant application, contains the phrase “a storage device for providing storage for digital images of a plurality of unrelated image providers, the storage device storing the digital images of a first one of the image providers such that the digital images of the first image provider can only be accessed by authorized users identified by the first image provider and such that the digital images of the first image provider are transparent to users that are not authorized by the first image provider; a searching engine for developing a subset of the digital images

Art Unit: 3624

stored in the storage device by the first image provider in response to inputs received from the first image provider, the searching engine being adapted to download low resolution copies of the subset to the first image provider; a mail server for e-mailing a notification message from the first image provider to a first authorized user identified by the first image provider via the Internet a transmitter for transmitting at least a portion of a pathname to the first authorized user via the Internet and a router for electronically routing at least one high resolution copy of a digital image contained in the subset and identified by the first authorized user to a printer."

Claim 12 of the '146 patent contains all of the claim limitations of claim 108 except the phrases "a mail server for e-mailing a notification message from the first image provider to a first authorized user identified by the first image provider via the Internet and a transmitter for transmitting at least a portion of a pathname to the first authorized user via the Internet. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the '146 patent to arrive at claim 108 of the instant application, by simply including the steps of "a mail server for e-mailing a notification message from the first image provider to a first authorized user identified by the first image provider via the Internet and a transmitter for transmitting at least a portion of a pathname to the first authorized user via the Internet." The scope of claim 108 of the '146 patent reference encompasses all of the elements of the instant claim 108 except the steps of "a mail server for e-mailing a notification message from the first image provider to a first authorized user identified by the first image provider via the Internet and a transmitter for transmitting at least a portion of a pathname to the first authorized user via the Internet."

With respect to claim 109 of the instant application, contains the phrase " wherein the digital images are input to the system by the first image provider via a

Art Unit: 3624

communication device" which encompasses all of the elements of the instant claim 13 of the '146 patent reference.

With respect to claim 110 of the instant application, contains the phrase "an image handler for processing the digital images input by the first image provider, the image handler being adapted to develop low resolution images of the digital images received from the first image provider and to store both the digital images received from the first image provider and the low resolution images thereof in the storage device in an addressable fashion for future searching" which encompasses all of the elements of the instant claim 14 of the '146 patent reference.

With respect to claims 111 & 126 of the instant application, contains the phrases, "storing a high resolution and a low resolution copy of each of a first plurality of digital images provided by a first image provider in an electronically searchable format on a storage device; storing a high resolution and a low resolution copy of each of a second plurality of digital images provided by a second image provider in an electronically searchable format on a storage device; permitting the first image provider to locate and download a low resolution copy of at least one of the digital images provided by the first image provider, the second plurality of digital images being transparent to the first image provider; e-mailing a notification message via the Internet to a first authorized user identified by the first image provider; transmitting at least a portion of a pathname associated with the at least one digital image to the first authorized user via the Internet receiving a request to download from the first authorized user, the request identifying the at least one digital image; receiving instructions from the first authorized user directing that the at least one digital image be printed; and automatically electronically routing the high resolution copy of the at least one digital image to a printer" and claim 126 contains the phrases "the second plurality of digital images being transparent to the

Art Unit: 3624

first image provider and the first plurality of digital images being transparent to the second image provider and automatically electronically routing via the Internet a low resolution copy of at least one of the digital images provided by the first image provider to a first authorized user identified by the first image provider". Claim 17 of the '146 patent contains all of the claim limitations of claim 111 except the phrases "e-mailing a notification message via the Internet to a first authorized user identified by the first image provider; transmitting at least a portion of a pathname associated with the at least one digital image to the first authorized user via the Internet receiving a request to download from the first authorized user, the request identifying the at least one digital image; receiving instructions from the first authorized user directing that the at least one digital image be printed; and automatically electronically routing the high resolution copy of the at least one digital image to a printer, the second plurality of digital images being transparent to the first image provider and the first plurality of digital images being transparent to the second image provider and automatically electronically routing via the Internet a low resolution copy of at least one of the digital images provided by the first image provider to a first authorized user identified by the first image provider".

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the '146 patent to arrive at claim 111 of the instant application, by simply including "e-mailing a notification message via the Internet to a first authorized user identified by the first image provider; transmitting at least a portion of a pathname associated with the at least one digital image to the first authorized user via the Internet; receiving a request to download from the first authorized user, the request identifying the at least one digital image; receiving instructions from the first authorized user directing that the at least one digital image be printed; and automatically electronically routing the high resolution copy of the at least one digital image to a

• Art Unit: 3624

printer; the second plurality of digital images being transparent to the first image provider and the first plurality of digital images being transparent to the second image provider and automatically electronically routing via the Internet a low resolution copy of at least one of the digital images provided by the first image provider to a first authorized user identified by the first image provider". The scope of claim 17 of the '146 patent reference encompasses all of the elements of the instant claim 111 except the steps of "e-mailing a notification message via the Internet to a first authorized user identified by the first image provider; transmitting at least a portion of a pathname associated with the at least one digital image to the first authorized user via the Internet; receiving a request to download from the first authorized user, the request identifying the at least one digital image; receiving instructions from the first authorized user directing that the at least one digital image be printed; and automatically electronically routing the high resolution copy of the at least one digital image to a printer; the second plurality of digital images being transparent to the first image provider and the first plurality of digital images being transparent to the second image provider and automatically electronically routing via the Internet a low resolution copy of at least one of the digital images provided by the first image provider to a first authorized user identified by the first image provider".

With respect to claim 112 of the instant application, contains the phrases "a storage device for storing digital images received from a first digital image provider and a second digital image provider; a searching engine for developing a subset of the digital images stored in the storage device in response to inputs received from a first user, the searching engine being adapted to download low resolution copies of the subset to the first user; a job order developer responsive to inputs received from the first user for developing a job order which includes at least one high resolution copy of a

•Art Unit: 3624

digital image contained in the subset and identified by the first user; a router for electronically routing the job order developed by the job order developer to a printer; a user identifier for discriminating between users communicating with system to control user access to the digital images stored in the storage device, the user identifier limiting access to the digital images provided by the first digital image provider to at least one user identified by the first digital image provider, wherein the digital images provided by the first digital image provider are transparent to all users except users identified by the first digital image provider; a mail database for e-mailing a notification message to the at least one user identified by the first digital image provider; and a transmitter for transmitting at least a portion of pathname to the at least one user identified by the first digital image provider.” Claims 20 & 23 of the ‘146 patent contains all of the claim limitations of claim 112 except the phrases “a mail database for e-mailing a notification message to the at least one user identified by the first digital image provider; and a transmitter for transmitting at least a portion of pathname to the at least one user identified by the first digital image provider.” However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the ‘146 patent to arrive at claim 112 of the instant application, by simply including “a mail database for e-mailing a notification message to the at least one user identified by the first digital image provider; and a transmitter for transmitting at least a portion of pathname to the at least one user identified by the first digital image provider.” The scope of claims 20 & 23 of the ‘146 patent reference encompasses all of the elements of the instant claim 112 except the steps of “a mail database for e-mailing a notification message to the at least one user identified by the first digital image provider; and a transmitter for transmitting at least a portion of pathname to the at least one user identified by the first digital image provider.”

•Art Unit: 3624

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hunt et al (US 5,764,235) disclosed techniques for transmitting graphical images.

Sekiguti, Kiyonori (EP0 887994A1) disclosed an image transmission apparatus.

Inquiries

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for Official communications and 703-746-5622 for Non-Official communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



E. Colbert
July 29, 2002